

## **REMARKS**

### **A. Background**

Applicants wish to express appreciation to the Examiner for the interview that was conducted on May 19, 2004. During the interview, the commercial success of Applicants' products was discussed. Although agreement was not reached, Applicants reserve the right to introduce evidence of commercial success in subsequent correspondence.

Claims 1-20, 23, and 25-37 were previously canceled. Claims 39 and 47 are canceled with this amendment. Claims 21 and 44 are amended in this Response. Claims 21, 22, 24, 38, 40-46, and 48-51 are now pending.

### **B. Summary**

The references cited by the Examiner do not combine analogous art. There is no suggestion or motivation in the cited art to make the combinations mentioned by the Examiner. The *Bridenbaugh* reference does not teach or suggest a motor that biases the bed toward a storage position. Instead, the motor appears to be fixed and does not move with respect to the bed frame.

### **C. Rejection of Claims 21, 22, 24, 38-41, and 44-49 under 35 U.S.C. § 103(a)**

Claims 21, 22, 24, 38-41 and 44-49 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,664,646 issued to Rorabaugh (hereinafter "*Rorabaugh*") in view of U.S. Patent No. 2,067,136 issued to Bridenbaugh (hereinafter "*Bridenbaugh*"). The Examiner acknowledged that *Rorabaugh* does not disclose a motor attached to the treadbase located forward of the pivot point. The Examiner further stated "It would have been obvious to

use *Bridenbaugh's* location of the motor with *Rorabaugh's* treadmill and motor, as it is well known, as taught by *Bridenbaugh*, to have a motor located in front of a pivot point in folding mechanism (sic), for providing a counterweight to the lifting mechanism, and as it is well known to use multiple types of weights for providing a counterbalancing means."

With reference to claims 38-41, the Examiner further mentioned that *Bridenbaugh* discloses "an electric motor controlling mechanism located forward of the pivot point (77), the motor has a weight and biased the base in the storage position (fig. 1), lift assist means connected between the support structure and the base for assisting a user comprising a pneumatic cylinder (col. 3, lines 27-54)."

**D. Rejection of Claims 42 and 50 under 35 U.S.C. § 103(a)**

Claims 42 and 50 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Rorabaugh* in view of *Bridenbaugh*, and further in view of U.S. Patent No. 4,370,766 issued to Teague, Jr. (hereinafter "*Teague*"). The Examiner acknowledged that *Rorabaugh* does not disclose a gas spring connected between the support structure and the tread base. *Teague* discloses a panel bed having a gas spring to assist in lifting the bed. The Examiner maintains that it would have been obvious to combine *Rorabaugh* and *Bridenbaugh* with *Teague*.

**E. Rejection of Claims 43 and 51 under 35 U.S.C. § 103(a)**

Claims 43 and 51 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Rorabaugh* in view of *Bridenbaugh*, and further in view of U.S. Patent No. 4,026,545 issued to Schöeneberger (hereinafter "*Schöeneberger*"). The Examiner acknowledged that *Rorabaugh* and *Bridenbaugh* do not specifically detail a latch for securing a tread base when in the storage

position. *Schöneneberger* discloses a conventional latch means for securing a tread base when in the storage position. The Examiner maintains "It would have been obvious to use *Schönenberger's* catch means when *Rorabaugh* and *Bridenbaugh's* are in the storage position, as it is well known to use a latch means, as taught by *Schönenberger*, for holding a base frame in a storage position."

**F. Applicant Remarks and Arguments Overcoming These Rejections**

Applicants respectively traverse each of these rejections, and submit the following arguments in support of Applicants' position. First, according to MPEP §2141.01(a), to rely on a reference under 35 U.S.C. §103, it must be analogous prior art:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

Applicants submit that the *Bridenbaugh* and *Teague* references are non-analogous art. Applicants believe that one skilled in the art of making treadmills in 1996 would not have thought to examine the art of beds, particularly when one of the references (*Bridenbaugh*), was over 60 years old. The *Bridenbaugh* and *Teague* references should, therefore, be withdrawn.

While Applicants believe claims 21 and 44 distinguish over the art of record as originally written, Applicants have amended claims 21 and 44 to positively recite "wherein the motor has a weight and wherein the weight of the motor biases the tread base in the storage position." Applicants further believe that, in light of this amendment and the remarks presented below, claims 21 and 44 now definitely patentably distinguish over the references of record.

Even if *Bridenbaugh* and *Teague* are analogous art, Applicants believe that the Examiner has failed to set forth a *prima facie* case for obviousness using the art cited. To set forth a *prima facie* case of obviousness the following elements must be shown, according to M.P.E.P. §2143:

- (1) suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify the reference or combine reference teachings;
- (2) ...
- (3) the combined references must teach or suggest all the claim limitations of the Applicant's claims.

Additionally, the fact that the references can be combined is not sufficient to establish *prima facie* obviousness unless the prior art, in addition, suggests the desirability of the combination. M.P.E.P. §2143.01.

*Rorabaugh* is directed to a support structure and a tread base. However, *Rorabaugh* does not disclose a need for "a motor attached to the tread base and located forward of the pivot point, wherein the motor has a weight and wherein the weight of the motor biases the tread base in the storage position" as recited in claims 21 and 44. Accordingly, the *Rorabaugh* patent provides no suggestion or motivation for combining the references in the manner suggested by the Examiner.

*Bridenbaugh* discloses a folding bed with a motor. However, there is no support in the specification, claims, or drawings of the *Bridenbaugh* patent that the weight of the motor counterbalances the weight of the bed. In fact, *Bridenbaugh* seems to show just the opposite, i.e. that the *Bridenbaugh* motor is fixed within the wall space. This is evident from the mechanical nature of the *Bridenbaugh* mechanism. The motor (51) drives a shaft (50a) that is fixed to a gear (49) that engages a second gear (50). It is the turning of this shaft that provides the hydraulic pressure that operates the very complex mechanism that raises and lowers the bed. In order to be mechanically operational, this motor/shaft combination must be stationary with respect to the movement mechanism.

Accordingly, the *Bridenbaugh* patent does not provide a suggestion or motivation for combining the references in the manner suggested by the Examiner. Furthermore, one skilled in the exercise equipment art would not logically look to prior art dealing with beds to obtain features or structures to be used with exercise equipment. Further still, folding treadmills have been in existence for over 90 years (as evidenced by U.S. Patent No. 931,394, issued to *Day* in August, 1909), yet in all that time, no mention or discussion whatsoever is found in the cited prior art directed to the need or desirability of using a motor as a counterbalance to assist in lifting the tread base from an operating position to a storage position. Finally, even if the references were properly combined, the *Bridenbaugh* reference does not teach or suggest the element of "a motor attached to the tread base and located forward of the pivot point, wherein the motor has a weight and wherein the weight of the motor biases the tread base in the storage position" as recited in claims 21 and 44.

With respect to the rejections of claims 42 and 50, *Teague* discloses a counterbalancing mechanism for a panel bed (*i.e.*, a "Murphy bed") that uses a gas spring as part of the counterbalancing mechanism (Figures 2-4). Counsel for Applicants has studied the *Teague* patent, but has found no reference to any teaching, suggestion or motivation directed, either explicitly or by implication, to the need or desirability of applying the counterbalance mechanism disclosed therein to any other application or field of art. Furthermore, Applicants respectively submit that one skilled in the exercise equipment art would not logically look to prior art dealing with beds to obtain features or structures to be used with exercise equipment. As noted above, folding treadmills have been in existence for over 90 years (as evidenced by the *Day* patent), yet in all that time, no mention or discussion whatsoever is found in the cited prior

art directed to the need or desirability of using a gas spring to assist in lifting the tread base from an operating position to a storage position.

To be properly combinable, the cited references must teach or suggest some motivation for combining the references in the manner suggested by the Examiner. The Federal Circuit's holding in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), is instructive on this issue. *Dembiczak* involved a patent on an orange-colored garbage bag, having indicia printed on the outside of the bag so that, when full, it produces the appearance of a Jack-O-Lantern. Rejecting the claims under Section 103, the Examiner combined orange-colored garbage bags that were found to exist in the prior art with a prior art children's book teaching how to produce Jack-O-Lanterns from lunch sacks by drawing eyes, a nose and a mouth on the lunch sack. Reversing the rejection, the Federal Circuit set forth the following requirements on combining references under Section 103:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is **rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.** [citations omitted] **Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight.** [citations omitted]

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . . **The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.** [citations omitted] **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."**

*In re Dembiczak*, 50 U.S.P.Q.2d at 1617 (emphasis added).

In the present case, after briefly summarizing the basic teachings of *Rorabaugh*, *Bridenbaugh* and *Teague*, the Examiner makes broad conclusory statements to the effect that it

would have been obvious to combine the teachings of these references from unrelated fields of art. Applicants have studied the cited references and have been unable to locate any teaching, suggestion or motivation for combining the references in the manner proposed by the Examiner. Applicants would appreciate it if the Examiner would point out, by column and line numbers, the teaching or suggestion to combine these references that is considered relevant by the Examiner.

The Examiner may not, with the benefit of hindsight and armed with Applicants' invention as a road map, indiscriminately pick and choose from among discrete and unrelated parts of the prior art (especially non-analogous prior art) as a mosaic to recreate a facsimile of Applicants' invention. *Compare Akzo N.V. v. United States*, 808 F.2d 1471 (Fed. Cir. 1986). Applicants therefore respectfully request that the obviousness rejections cited by the Examiner with respect to claims 21, 22, 24, 38, 40-46, and 48-51 be withdrawn. Since independent claims 21 and 44 distinguish over the art of record, claims 22, 24, 38, 40-43 and 45-51, dependent therefrom, also patentably distinguish over the art.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 25<sup>th</sup> day of May, 2004.

Respectfully submitted,



Joseph L. Krupa  
Registration No. 44,852  
Attorney for Applicant  
Customer No. 022913

WORKMAN NYDEGGER  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Phone: (801) 533-9800  
Fax: (801) 328-1707

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